

REMARKS

This application was originally filed on 21 December 1999 with ten claims, three of which were written in independent form. No claims have been allowed. Claim 1 has been amended herein in a non-narrowing manner to clarify what is being claimed.

Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,309,073 to Nakayama et al. ("Nakayama") in view of U.S. Patent No. 5,451,980 to Simon et al. ("Simon"). The applicant respectfully disagrees.

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

The Examiner has the duty to present a prima facie obviousness rejection. Under *Graham*, this requires determining the differences between the prior art and the claims at issue. The Examiner has failed to read the prior art onto the limitations recited by the claims at issue. For example, Claim 1 recites, a "color modulator comprised of a stack of at least two dielectric layers and at least three transparent electrode layers." Nakayama in view of Simon does not show, teach, or suggest "at least three transparent electrode layers" as recited by Claim 1. Claim 7 recites "alternating layers of electrodes and dielectric materials." Nakayama in view of Simon does not show, teach, or suggest "alternating layers of electrodes and dielectric materials" as recited by Claim 7. Claim 10 recites, "passing said beam of white light through a stack of at least two dielectric layers, at least one of said dielectric layers exposed to an electric field." Nakayama in view of Simon does not show, teach, or suggest "passing said beam of white light through a stack of at least two dielectric layers, at least one of said dielectric layers exposed to an electric

field" as recited by Claim 10. Claim 11 recites, "alternating layers of electrodes and dielectric materials." Nakayama in view of Simon does not show, teach, or suggest "alternating layers of electrodes and dielectric materials" as recited by Claim 11.

Claims 2-6 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. Claims 8 and 9 depend from Claim 7 and should be deemed allowable for that reason and on their own merits. Claims 12 and 13 depend from Claim 11 and should be deemed allowable for that reason and on their own merits.

For the reasons stated above, the Examiner has not met the burden of presenting a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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